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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,941	10/21/2003	Matthew T. Adams	13563	4028
7590 ORUM & ROTH 53 W. JACKSON BLVD CHICAGO, IL 60604		05/17/2007	EXAMINER DICUS, TAMRA	
			ART UNIT 1774	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,941

Applicant(s)

ADAMS ET AL.

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9-11 and 30-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

The RCE is acknowledged.

Claim Objections

1. Claim 11 is objected to because of the following informalities: there is space between “ink” and the period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4, 30, 35-36 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in a prior Office Action of 12-28-06.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-5, 9-11, 30-32, 34, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. in view of He et al.
6. Schmidt teaches a medium comprised of fabric or textile woven or knitted yarn of polymeric material such as polyester polyethylene terephthalate (PET) (inherently transparent,

Art Unit: 1774

instant claims 4, 34, 36) (2:5-60, 10:50-68) being printed with plural overlapping ink layers in any color forming an image (same or different for either ink layer, embraces any color or effects instantly claimed in claims 1, 9-11, 30-32, 36-39) (11:1-45, 12:1-26, 17:1-55). Schmidt teaches the medium can be applied to garments (coated silk and cotton textiles either serve as a surface composite).

7. Schmidt does not expressly teach said garments have indicia or a bar code image or a resin material that is used to adhere the medium to it, or a light-colored fabric (instant claim 1, 4-5, 9-10, 30-32, 36-37-39).

8. He teaches a medium used as a label with overlapping ink in any desired image print (indicia, bar code is an obvious choice) having the label medium adhered to a garment (on light or dark colored fabrics, having high resolution inks that adhere well to fabric) via heat and by the resin adhesive layer that (heat curable) attaches to the surface of a garment (Figs 2(a) -2(b) and 11 and associated text, 0010, 0014, 0023-0025, 0041, 0078-0080, 0083-0090, 0093-0100, 0105, 018, 0127, 0136-0140). He also teaches registration marks (bar codes) on the medium.

9. It would have been obvious to one having ordinary skill in the art to have modified the medium of Schmidt to include a bar code, composite, resin layer and light colored composite as claimed because He teaches any image is printed on the medium and the light or dark colored composite garment/fabric and employs an adhesive resin layer to attach a similar medium via heat in order to decorate a garment composite or when security inks are used, to indicate counterfeit detection, and when using light colored fabrics, a high resolution image adheres well to fabric as cited above.

Art Unit: 1774

10. That the ink indicia are from a thermal printer is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

11. Claims 3 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. in view of He et al. and further in view of Asada.

The combination is relied upon above.

The combination does not teach the amounts of instant claims 3 and 33.

Asada teaches a medium cloth having 50 yarns/cm and up to 1 billion yarns/cm² having a bar code on it (while not claiming the amount of instant claim 3, is an optimizable feature dependent upon how light one desires the fabric) (Example 1). It would have been obvious to one having ordinary skill in the art to have modified the combination to have the recited amounts of threads/in since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. in view of He et al. and further in view of Kaminsky et al.

The combination is relied upon above.

The combination does not teach the material of instant claim 35, while teaching cotton.

Kaminsky teaches fabric imaging where fabric of cotton or fiberglass are equivalents used as materials for fabrics and fiberglass adds stiffness (5:15-45, 6:19-45).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include fiberglass as claimed because Kaminsky teaches cotton and fiberglass are equivalents used as the material for fabrics, where fiberglass adds stiffness as cited above.

Response to Arguments

12. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant argued the 112 rejection above to not determining whether mesh or the resin are individually transparent; however, the rejection is maintained because if the examiner has to guess which layer is transparent, it is not clear. All other references are used for the same reasons as prior. All other arguments are moot.

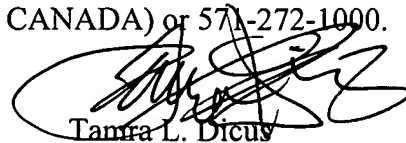
Art Unit: 1774

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

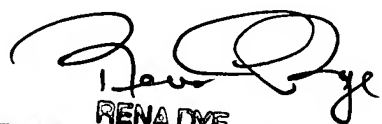
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus
Examiner
Art Unit 1774

May 11, 2007



RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1774